

P. 1



## Children's Hospital Medical Center

## Children's Hospital

Elland and Bethesda Avenues  
Cincinnati, Ohio 45229-2899

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## FAX COVER SHEET

TO: HONORABLE HARRY MANBECK  
U.S. PATENT & TRADEMARK OFFICE

FROM: LELAND C. CLARK, JR. DATE: 2 JULY 1990

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COMMENTS: \_\_\_\_\_

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2 July 1990

SENT VIA FACSIMILE

Honorable Harry Manbeck  
Commissioner of Patents  
United States Patent and Trademark Office  
2021 Jefferson Davis Highway  
Arlington, VA 20231

Dear Commissioner Manbeck:

I would like to know the fees involved in reinstating my U.S. patent "Methods of treating disorders of an eye with liquid perfluorocarbons," Patent No. 4,490,351, Filed March 15, 1982 and Issued December 25, 1984, for which the maintenance fee, due in June of 1987 was not paid.

I urgently request this information. I have an account which will promptly pay whatever expenses (fees and surcharges for late payment) are required to reinstate this patent. This lack of payment, in my opinion was unavoidable. The patent is needed to protect continued commercial development and perfection of this invention.

I truly hope that this plea from an inventor will be heard and a favorable response given.

Dr. Gholam Peyman, an outstanding ophthalmic surgeon, and I have collaborated, and are collaborating, in research involving the use of certain fluorocarbon liquids as temporary vitreous replacements for retinal tamponade in retinal surgery.

Our laboratory has for many years intensively worked on the preparation of ultra pure fluorocarbons for use as the oxygen-transport component of blood substitutes. Because of our extensive experience and technical know-how we have been able to prepare fluorocarbons specifically selected, purified, and characterized for use in eye surgery. One of these, perfluorophenanthrene, was supplied in a partially purified commercial grade by Air Products and then purified much further here by proprietary adsorption and preparative gas chromatography techniques. These pure fluorocarbon materials have now been shown to be valuable in certain types of difficult retinal surgery and are presently being clinically evaluated by Dr. Peyman. The work is attracting international attention in the field of ophthalmology because of its importance. The commercial availability of ultrapure definable retinal surgery fluorocarbons is of considerable medical significance. Patent protection is therefore essential to encourage a company to provide sterile specially prepared fluorocarbon liquids, partly because there is only a small specialized market.

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Honorable Harry Manbeck  
2 July 1990  
Page Two

It came as a great shock to me to learn that the maintenance fee for this patent had not been paid when due. I learned of this after many weeks of discussion where I was able to make arrangements to license a small company that was very interested in marketing this product and I signed a license agreement with them (Vitrophage) several months ago, completely unaware that U.S. maintenance fees had apparently never been paid. On the other hand, the foreign annuities for the corresponding patents have been paid, or are being paid, and these patents are in force. A fee has been paid in Japan so that the application will be examined there. The U.S. patent, like others which have issued here in my name, was assigned to the Children's Hospital Research Foundation. In my opinion, the stewardship of this property rested in their hands. I assumed that the various fees required by the U. S. patent office would be paid by the Foundation or their attorney. I had no reason to believe otherwise. As I say, I was surprised to find this to be not so.

Since I was never informed that they were not paying the fees, and I was never asked to pay a fee, I find the present state to be unavoidable on my part.

According to the policy entitled "Children's Hospital and Children's Hospital Research Foundation Patent Policy," the inventor must be notified of the Foundation's decision as to whether or not they wish to proceed with a patent application or release the rights to the inventor. The employee agreement also provides for the Foundation to relinquish rights to inventions to the inventor if deemed desirable. In accordance with this policy, late last fall, I was informed by the patent attorney that the Children's Hospital Research Foundation had decided they would relinquish the rights to me if I wanted to continue the payments needed to keep it viable.

I must emphasize my shock and horror to discover after all my work and my valuable discussions with Vitrophage, made with Dr. Peyman's encouragement and approval, that all of these great efforts could be lost, because those responsible in this institution had not paid the U.S. maintenance fees, nor properly notified me on time that they should be paid.

Sincerely,

*Leland C. Clark, Jr.*

Leland C. Clark, Jr., Ph.D., D.Sc.  
University Distinguished Service Professor

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DEPUTY ASSISTANT  
COMMISSIONER FOR PATENTS

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